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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,082	10/06/2003	Jacobus M. Lemmens	116.066	4414

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EXAMINER	
KRASS, FREDERICK F	

ART UNIT	PAPER NUMBER
1614	

MAIL DATE	DELIVERY MODE
01/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/678,082	LEMMENS ET AL.	
	Examiner	Art Unit	
	Frederick Krass	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *51-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *51-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Previous Rejections

Unless specifically repeated/maintained infra, all previous rejections are withdrawn.

This action is NON-FINAL.

Obviousness Rejection

Claims 51-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pathak et al (USP 6,113,944) in view of Benneker et al (USP 5,874,447) and Chu (USP 4,675,188).

The primary reference discloses paroxetine formulations for oral administration which are prepared by dry granulating in the absence of water. See column 1, lines 50-58 and column 2, lines 64-67. Conventional excipients used include calcium phosphate, sodium starch glycollate, and magnesium stearate. See column 2, lines 12-16. Working example 2 discloses a formulation comprising sodium starch glycollate, calcium phosphate, and magnesium stearate; microcrystalline cellulose, lactose or any other diluent or excipient is not included therein. Dry granulation is taught to overcome the recognized problem of discoloration in which paroxetine takes on a pink hue (column 1, lines 35-47).

The primary reference differs from the instant claims insofar as it does not specify the use of sulfonate salts of paroxetine (it instead exemplifies the hydrochloride). It also does not specify the use of calcium hydrogen phosphate anhydrate in the form of plate shaped crystals or agglomerates thereof (= the commercially available product "A-Tab"). Instead, the reference

discloses the use of commercially available dicalcium phosphate dihydrates, i.e. "Emcompress" or "Ditab" (column 3, line 17).

Benneker et al teach that paroxetine sulfonate salts (such as paroxetine methane sulfonate) are preferable to paroxetine hydrochloride salts because the former do not undergo the discoloration associated with the latter when tabletted, and because the former have better water solubility (and thus better bioavailability). See column 1, lines 30-65. See also column 7, lines 8-13 (teaching that either wet or dry granulation may be used). Excipients are only generally taught.

Chu teaches that thermally dehydrated dicalcium phosphates are preferred for use in direct compression tabletting because they provide increased compressibility (column 2, lines 59-62), as compared to other conventional dicalcium phosphate products, including dibasic calcium phosphate dehydrate (column 1, lines 45-50). Paroxetine is not specifically disclosed.

It would have been obvious to have used a paroxetine sulfonate instead of hydrochloride in formulating the pharmaceutical compositions of the primary reference, motivated by the desire to further enhance discoloration resistance as taught by Benneker et al. Similarly, it would have been obvious to have thermally dehydrated the "Encompress/Di-Tab" filler of the primary reference, in order to provide increased compressibility as taught by Chu.[1]

Regarding claims 56-59, the pharmaceutical compositions suggested by the combined teachings of the primary and secondary references differ from the instant claims insofar as specific pH values are not provided. Generally, however, it is prima facie obvious to determine

[1] Dehydrating "Emcompress" or "Di-Tab" results in "A-Tab", the same product preferred by applicant. See the printouts for Chemical Abstracts Registry Numbers 7757-93-9 and 7789-77-7.

workable or optimal values within a prior art disclosure through the application of routine experimentation. *See* In re Aller, 105 USPQ 233, 235 (CCPA 1955); In re Boesch, 205 USPQ 215 (CCPA 1980); and In re Peterson, 315 F.3d 1325 (CA Fed 2003). Accordingly, it would have been obvious to have adjusted the relative percentages of the components suggested by the combined teachings of the primary and secondary references to arrive at those pH values providing optimal performance for a particular given pharmaceutical formulation, per the reasoning of the cited precedent.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick Krass whose telephone number is (571) 272-0580. The examiner can normally be reached at (571) 272-0580 on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick Krass
Primary Examiner
Art Unit 1614